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Keating & Bennett LLP
Suite 312
10400 Eaton Place
Fairfax VA 22030

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OFFICE OF PETITIONS

In re Application of
Jun Endo et al.
Application No. 10/728,464
Filing Date: December 5, 2003
Attorney Docket No. 36856.1172
Title: POINTING DEVICE AND METHOD
OF PRODUCING THE SAME

DECISION ON PETITION

BACKGROUND

This is a decision on the petition filed July 9, 2004, requesting that the above-identified application be accorded a filing date of December 5, 2003, with Figure 3 as part of the original disclosure of the application.

The application was deposited December 5, 2003. However, on July 1, 2004, the Office of Initial Patent Examination (OIPE) mailed a notice stating that the application had been accorded a filing date of December 5, 2003, and that the application appeared to have been deposited without Figure 3.

With the instant petition, Petitioner has submitted a copy of Figure 3 along with the petition fee. Petitioner has asserted that Figure 3 was included on filing. In order to support this allegation, Petitioner has included a copy of his postcard receipt acknowledging receipt of "drawings 7 sheets (formal)" in the United States Patent and Trademark Office (Office) on December 5, 2003.

THE RELEVANT SECTION OF THE MPEP

Section 503 of the MPEP, entitled Application Number and Filing Receipt, sets forth, in part:

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as prima facie evidence of receipt of that item in the USPTO.

ANALYSIS

It is noted that the electronic file contains 7 pages of drawings, containing Figures 1-2, 5-7, and two copies of Figure 4. Figure 3 has not been located in the electronic file.

Obviously, the degree on which applicants may rely on a postcard receipt to establish receipt of a particular item depends on the specificity of the itemization. Since the postcard indicates that 7 pages of drawings were included on filing, and 7 pages of drawings were indeed located in the electronic file, it appears that each of the seven pages which were submitted made their way into the electronic file. Unfortunately, figure 3 does not appear to be among these pages.

The PTO file is the official record of all papers filed in this application. A review of the official file reveals that Figure 3 was not received on filing. Instead, a duplicate copy of Figure 4 appears to have been filed in its stead. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. Petitioner's assertion that figure 3 was included on filing is not more persuasive than either the electronic file or the postcard receipt which he prepared and submitted.

As such, it appears that Figure 3 was not filed with the Office on December 5, 2003. For this reason, the petition cannot be granted.

CONCLUSION

For these reasons, the petition is **DISMISSED**.

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The application file is being returned to OIPE for further processing with a filing date of December 5, 2003, using only the application papers which were filed on that date. Figure 3 will not be entered.

If petitioner desires for the examiner to consider this page which was not submitted as part of the original disclosure, then petitioner may submit this figure via an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

¹ See MPEP 608.02(h) and 608.04.